

Notice of Allowability	Application No.	Applicant(s)	
	10/031,014	HOWARD, ANDREW D.	
	Examiner	Art Unit	
	Michael Pak	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 8-4-2003.
2. ☒ The allowed claim(s) is/are 1, 5-10, 12-17.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date <u>8-4-03</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

EXAMINER'S AMENDMENT

1. The title has been amended to "Nucleic acid encoding melanin-concentrating hormone receptor."
2. The preliminary amendment filed 10 January 2002 has been entered.
3. The information disclosure statement filed 4 August 2003 was considered and attached.

Election/Restriction

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-18, drawn to a DNA encoding SEQ ID NO: 4 and 6, expression vectors, and host cells, cDNA library, a polynucleotide, a polynucleotide probe, and nucleic acid, classified in class 536, subclass 23.5.
 - II. Claims 1-18, drawn to a DNA encoding SEQ ID NO:8, expression vectors, and host cells, cDNA library, a polynucleotide, a polynucleotide probe, and nucleic acid, classified in class 536, subclass 23.5.
 - III. Claims 19-21, drawn to a polypeptide of SEQ ID NO:4 and 6, classified in class 530, subclass 350.
 - IV. Claims 19-21, drawn to a polypeptide of SEQ ID NO:8, classified in class 530, subclass 350.

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V. Claims 22-31, drawn to a method of screening a compound, classified in class 435, subclass 7.2.

VI. Claims 32-330, drawn to a method of suppressing appetite, classified in class 514, subclass 44.

The inventions are distinct, each from the other because of the following reasons.

The products of inventions I-IV, are distinct each from the other, because they are drawn to products having materially different structures and functions.

The methods of inventions V-VI, are distinct, each from the other, because they are drawn to processes having materially different process steps, which are practiced for materially different purposes.

Inventions of products of Group I-IV, and the processes of Groups V-VI are related as products and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the products can be used in the alternative processes of any one of Groups V-VI.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their different classifications, restriction for examination purposes as indicated is proper.

During a telephone conversation with Attorney Sheldon Heber on February 24, 2005 a provisional election was made Group I with traverse to prosecute the invention

of Group I, claim 1-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 19-33 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

5. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Attorney Sheldon Heber on 14 March 2005.

Cancel claims 2-4, 11, and 18-33.

Amend:

Claim 1, line 2, replace "SEQ. ID. NO. 4, SEQ. ID. NO. 6 or SEQ. ID. NO. 8" with -- SEQ ID NO: 4 or SEQ ID NO: 6 --.

Claim 9, line 2, replace "SEQ. ID. NO. 4, SEQ. ID. NO. 6 or SEQ. ID. NO. 8" with -- SEQ ID NO: 4 or SEQ ID NO: 6 --.

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Claim 16, line 1, replace "recombinant" with isolated --.

Claim 17, line 2, delete "recombinant".

Claim 17, line 3, insert after "vector" with -- and isolate the polypeptide --.

6. The following is an examiner's statement of reasons for allowance:

The closest prior art of record, Salon et al.(US 6,221, 613), does not anticipate or fairly suggest the claimed invention because the prior art do not teach the claimed nucleic acid encoding a melanin-concentrating hormone receptor with the specific sequence.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday through Friday from 8:30 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (571) 272-0829.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

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A handwritten signature in black ink, appearing to read "Michael Pak".

Michael Pak

Primary Patent Examiner

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18 March 2005